

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

LEVERGOOD *et al.*

Appl. No.: 09/548,235

Filed: April 12, 2000

For: **Web Advertising Method**

Confirmation No.: 6069

Art Unit: 2452

Examiner: WINDER, Patrice L.

Atty. Docket: 3057.0020002

Twentieth Supplemental Information Disclosure Statement

Mail Stop Amendment

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Commissioner:

Notice of Prior and Concurrent Proceedings

Applicants hereby call to the attention of the Patent and Trademark Office the following reexamination proceedings involving a patent that is directly related to the above-identified patent application:

Proceeding	Status
<i>Ex Parte</i> Reexamination of U.S. Patent No. 5,708,780 (Control No. 90/007,183)	Reexamination Certificate Issued; March 15, 2006
<i>Ex Parte</i> Reexamination of U.S. Patent No. 7,272,639 (Control No. 90/011,444)	Reexamination Certificate Issued; September 29, 2011
<i>Ex Parte</i> Reexamination of U.S. Patent No. 7,272,639 (Control No. 90/011,937)	Response after Non-Final Action Entered; May 2, 2012

Documents which may be material to the related *Ex Parte* Reexaminations that are not already of record in this patent application are listed on the accompanying Form PTO/SB/08 and submitted herewith as documents **NPL1-NPL11**. If the Examiner should wish to review any other materials, information or documents from the related Reexaminations, copies can be provided to the Examiner upon request.

Notice of Related Litigation

Applicants hereby call to the attention of the Patent and Trademark Office the following litigations involving a patent that is directly related to the above-identified patent application:

Case	Status
<i>Sovereign Software LLC v. Amazon.com, Inc., et al.</i> (E.D. Tex. 6:04-cv-00014)	Dismissed
<i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511)	On appeal to the U.S. Court of Appeals for the Federal Circuit
<i>Sovereign Software LLC v. J.C. Penney Corporation, Inc. et al.</i> , (E.D. Tex. 6:09-cv-00274)	Pending

Documents which may be material to the related litigations that are not already of record in this patent application are listed on the accompanying Form PTO/SB/08 and submitted herewith as documents **NPL12-NPL30**. If the Examiner should wish to review any other materials, information or documents from the related Reexaminations, copies can be provided to the Examiner upon request.

Information Disclosure Statement

Listed on accompanying IDS Forms PTO/SB/08a equivalent and PTO/SB/08b equivalent are documents that may be considered material to the patentability of this application as defined in 37 C.F.R. §1.56, and in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.97 and 1.98.

Applicants have listed publication dates on the attached IDS Forms based on information presently available to the undersigned. However, the listed publication dates

should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☐ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed within three months of the date of filing of a national application other than a continued prosecution application (CPA), OR within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international application, OR before the mailing date of a first Office Action on the merits OR

before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.

- ☒ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.

☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- ☒ c. The required fee is provided through online credit card payment authorization in the amount of **\$180.00** in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but on or before payment of the Issue Fee. The required fee is provided through online credit card payment authorization in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38 and MPEP 609.04(a)(III).
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below in accordance with 37 C.F.R. § 1.98(a)(3).
- ☒ 7. Copies of documents **FP1** and **NPL1-NPL30** are submitted. However, in accordance with 37 C.F.R. § 1.98(a)(2), *no copy of U.S. patent and patent application publication cited as document US1 on the attached IDS Form is submitted.*
- ☐ 8. Copies of the _____ documents were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. _____, filed _____, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
- ☒ 9. It is expected that the examiner will review the prosecution and cited art in the parent application nos. **09/005,479**, filed January 12, 1998 (now U.S. Patent No. 7,272,639, issued September 18, 2007) and **08/474,096**, filed June 7, 1995 (now U.S. Patent No. 5,708,780, issued June 13, 1998) in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art

cited in the earlier prosecution history has been reviewed in connection with the present application.

- ☐ 10. In accordance with the Federal Circuit decision in *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358 (Fed. Cir. 2003), Applicants submit herewith Office Actions from the co-pending U.S. Patent Application No. _____, filed _____, as documents _____ to _____.


The identification of these Office Actions is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

It is respectfully requested that the Examiner initial and return a copy of the enclosed IDS Forms, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: 10 MAR 2012

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**TWENTIETH SUPPLEMENTAL
INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Complete if Known

Application Number	09/548,235
Filing Date	April 12, 2000
First Named Inventor	Thomas Mark LEVERGOOD
Art Unit	2452
Examiner Name	WINDER, Patrice L.
Attorney Docket Number	3057.0020002

Sheet	1	of	1
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U.S. PATENT DOCUMENTS

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FOREIGN PATENT DOCUMENTS

[illegible]

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Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or notation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Substitute for form 1449/PTO		Complete if Known	
TWENTIETH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		Application Number	09/548,235
		Filing Date	April 12, 2000
		First Named Inventor	Thomas Mark LEVERGOOD
		Art Unit	2452
		Examiner Name	WINDER, Patrice L.
		Attorney Docket Number	3057.0020002
Sheet	1	of	3

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
	NPL1	Franks et al., "An Extension to HTTP: Digest Access Authentication", Network Working Group, RFC 2069, January 1997, 18 pages.	
	NPL2	NON-FINAL OFFICE ACTION dated March 17, 2005, for Reexamination Control No. 90/007,183, filed August 24, 2004, in Reexamination of U.S. Patent No. 5,708,780, issued January 13, 1998, 35 pages.	
	NPL3	NOTICE of Intent to Issue a Reexamination Certificate, dated July 27, 2005, for Reexamination Control No. 90/007,183, filed August 24, 2004, in Reexamination of U.S. Patent No. 5,708,780, issued January 13, 1998, 6 pages.	
	NPL4	Novick, B., "The Clickstream", (9503) Internet Marketing: The Clickstream, retrieved from http://www.i-m.com/archives/9503/0375.html , March 20, 1995, 3 pages.	
	NPL5	Phillips, "SuperHighway Access Eases Internet Entry", Netweek: A Section for Implementers of Enterprise-Wide Systems, PC Week, October 31, 1994, 3 pages.	
	NPL6	REQUEST dated August 24, 2004, for ex parte reexamination of U.S. Patent No. 5,708,780 issued January 13, 1998, 73 pages.	
	NPL7	Rescorla, E. et al., "The Secure HyperText Transfer Protocol," Enterprise Integration Technologies, Experimental, Request for Comments XXXX, June 1994, 23 pages.	
	NPL8	Rescorla, E. et al., "The Secure HyperText Transfer Protocol," Internet-Draft (Expired May 1995), Enterprise Integration Technologies, December 1994, 35 pages.	
	NPL9	USPTO ORDER dated October 21, 2004, granting request for ex parte reexamination of U.S. Patent No. 5,708,780, issued January 13, 1998, 5 pages.	
	NPL10	NON-FINAL OFFICE ACTION dated March 1, 2012, for Reexamination Control No. 90/011,937, filed September 30, 2011, in Reexamination of U.S. Patent No. 7,272,639, issued September 18, 2007, 7 pages.	

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

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		Filing Date	April 12, 2000		
		First Named Inventor	Thomas Mark LEVERGOOD		
		Art Unit	2452		
		Examiner Name	WINDER, Patrice L.		
Sheet	2	of	3	Attorney Docket Number	3057.0020002
NON PATENT LITERATURE DOCUMENTS					
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume number, publisher, city and/or country where published			T ²
	NPL11	PATENT OWNER'S REPLY dated May 1, 2012, to First Office Action Under 37 C.F.R. § 1.111 and 1.550 in Ex Parte Reexamination with Exhibits, for Reexamination Control No. 90/011.937, filed September 30, 2011, in Reexamination of U.S. Patent No. 7,272,639, issued September 18, 2007, 152 pages.			
	NPL12	DECLARATION dated August 20, 2004, of John D. Vandenberg in Support of Defendant Amazon.com, Inc.'s Reply in Support of its Motion for Partial Summary Judgment of Non-Infringement ('780 Patent), <i>Soverain Software LLC v. Amazon.com, Inc., et al.</i> (E.D. Tex. 6:04-cv-00014), 3 pages.			
	NPL13	DECLARATION dated August 9, 2004, of Jack D. Grimes, Ph.D., in Opposition to Defendant Amazon.com, Inc.'s Motion for Partial Summary Judgment of Non-Infringement ('780 Patent), <i>Soverain Software LLC v. Amazon.com, Inc., et al.</i> (E.D. Tex. 6:04-cv-00014), 62 pages.			
	NPL14	THIRD SUPPLEMENTAL RESPONSE dated September, 2004, to Amazon.com's First Set of Interrogatories (Nos. 1-14), <i>Soverain Software LLC v. Amazon.com, Inc., et al.</i> (E.D. Tex. 6:04-cv-00014), 9 pages.			
	NPL15	UNOPPOSED MOTION dated May 18, 2005, by Amazon.com, Inc. for Leave to Amend its Answer to Include Allegations Regarding Stuff.com, <i>Soverain Software LLC v. Amazon.com, Inc., et al.</i> (E.D. Tex. 6:04-cv-00014), 9 pages.			
	NPL16	AMENDED COMPLAINT dated November 23, 2007, by Soverain Software LLC for Patent Infringement of U.S. Patent Nos. 5,715,314, 5,909,492, and 7,272,639, <i>Soverain Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 13 pages.			
	NPL17	BRIEF dated December 7, 2010, by Appellant Newegg, Inc., Appeal from the United States Court of Appeals, Federal Circuit No. 2011-1009, <i>Soverain Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 28 pages.			
	NPL18	BRIEF dated March 28, 2011, by Plaintiff-Appellee Soverain Software LLC, Appeal from the United States Court of Appeals, Federal Circuit No. 2011-1009, <i>Soverain Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 75 pages.			
	NPL19	COMPLAINT dated November 2, 2007, by Soverain Software LLC for Patent Infringement of U.S. Patent Nos. 5,715,314, 5,909,492, and 7,272,639, <i>Soverain Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 132 pages.			
	NPL20	MEMORANDUM OPINION AND ORDER dated August 11, 2010, ordered and signed by Judge Leonard Davis, <i>Soverain Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 32 pages.			

Examiner Signature	Date Considered
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		Filing Date	April 12, 2000		
		First Named Inventor	Thomas Mark LEVERGOOD		
		Art Unit	2452		
		Examiner Name	WINDER, Patrice L.		
Sheet	3	of	3	Attorney Docket Number	3057.0020002
NON PATENT LITERATURE DOCUMENTS					
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume number, publisher, city and/or country where published			T ²
	NPL21	MOTIONS <i>IN LIMINE</i> dated January 13, 2010, by Sovereign Software LLC, with attachments, <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 45 pages.			
	NPL22	OPPOSITION dated June 7, 2010, by Plaintiff Sovereign Software LLC, to Newegg's Renewed Motion for Judgment as a Matter of Law of Non-Infringement and Invalidity of the Asserted Claims and Alternative Motions for New Trial (Redacted), <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 29 pages.			
	NPL23	RENEWED MOTION dated May 24, 2010, by Plaintiff Sovereign Software LLC, for Judgment as a Matter of Law of Infringement of the '314, '492, and '639 Patents and for a New Trial on '639 Patent Damages (Redacted), <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 68 pages.			
	NPL24	RENEWED MOTIONS dated May 24, 2010, by Defendant Newegg, Inc., for Judgment as a Matter of Law of Non-Infringement and Invalidity of the Asserted Claims and Alternative Motions for New Trial (Redacted), <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 33 pages.			
	NPL25	REPLY BRIEF dated April 14, 2011, by Appellant Newegg, Inc., Appeal from the United States Court of Appeals, Federal Circuit No. 2011-1009, <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 13 pages.			
	NPL26	REPLY dated June 14, 2010, by Defendant Newegg, Inc., in Support of its Renewed Motion for Judgment as a Matter of Law of Non-Infringement and Invalidity of the Asserted Claims and Alternative Motions for New Trial (Redacted), <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 12 pages.			
	NPL27	REPLY dated June 14, 2010, by Plaintiff Sovereign Software LLC, in Support of its Renewed Motion for Judgment as a Matter of Law of Infringement of the '314, '492, and '639 Patents and for a New Trial on '639 Patent Damages (Redacted), <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 13 pages.			
	NPL28	RESPONSE dated June 7, 2010, by Defendant Newegg, Inc., to Sovereign's Renewed Motion for Judgment as a Matter of Law of Infringement and for a New Trial on '639 Patent Damages, <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 15 pages.			
	NPL29	SURREPLY dated June 21, 2010, by Defendant Newegg, Inc., in Opposition to Plaintiff Sovereign's Renewed Motion for Judgment as a Matter of Law of Infringement of the '314, '492, and '639 Patents, and for a New Trial on '639 Patent Damages, <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 8 pages.			
	NPL30	SURREPLY dated June 21, 2010, by Plaintiff Sovereign Software LLC, in Opposition to Newegg's Renewed Motion for Judgment as a Matter of Law of Non-Infringement and Invalidity of the Asserted Claims and Alternative Motions for New Trial (Redacted), <i>Sovereign Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511), 11 pages.			

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